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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,741	08/13/2001	Eyal Bartfeld	0128US-Eyal	8349
23521 7590 03/22/2007 SALTAMAR INNOVATIONS 30 FERN LANE SOUTH PORTLAND, ME 04106			EXAMINER YIMAM, HARUN M	
			ART UNIT 2623	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/928,741

Applicant(s)

BARTFELD, EYAL

Examiner

Harun M. Yimam

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 15, 16, 18, 19, 21-23 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 15, 16, 18, 19, 21-23 and 26-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 12/24/2006 regarding claims 27-29 have been fully considered but are moot in view of new grounds of rejection.

Applicant's arguments filed 12/24/2006 regarding claims 1 - 6, 15, 16, 18, 19, 21-23 and 26 - 29 have been fully considered but they are not persuasive.

2. In response to applicants' argument (page 6, 4<sup>th</sup> paragraph) regarding the 102 rejection of claim 6, applicants should note that the 102 rejection of claim 6 in the office action mailed 06/26/06 is identical to that of the 102 rejection of claim 6 in the office action mailed 05/22/06 and that it is clear that the previous Examiner forgot to remove said rejection after receiving the proposed amendments on 05/23/06.

3. In response to applicants' argument (page 7, 1<sup>st</sup> paragraph) that neither McKissick nor Brunet mention a messaging system as claimed and described in the present invention, applicants should note that McKissick explicitly discloses a television messaging system (20 in figure 1A) as claimed and described in the present invention without the text to speech module, which is disclosed by Brunet as explained in detail below.

4. In response to applicants' argument (page 7, 2<sup>nd</sup> paragraph) that neither references place the text to speech module as executable on the set-top box, applicants should first note that a computer, by definition, is a machine for manipulating data according to a list of instructions. Both a computer and a set-top box operate in the same manner and are similarly used in the field of applicants' endeavor. They both connect to a monitor/television and some external source of signal and turn the signal into content for display on the screen. In this case, **McKissick** discloses a television messaging system (figures 1A and 1B) comprising a set-top box (38 in figure 1B) capable of receiving a text message through a text entry device (34 in figure 1B) for display on television (40 in figure 1B) as well as for transmission to a target voice messaging system (audio voice mail equipment 22 in figure 1A) capable of receiving voice messages (paragraph 0030). McKissick further discloses that any suitable communications network including the Internet and a telephone network may be used to communicate said messages. However, McKissick fails to disclose a text to speech module for transforming said text into speech and producing a voice output corresponding to said text. **Brunet** discloses said text to speech module (a computer i.e., apparatus 14 of figure 1) for transforming said text into speech and producing a voice output corresponding to said text (column 2, lines 31-58). Furthermore, Brunet explicitly discloses that "the text to speech conversion may be done by any other suitable device" and it would have been obvious to one of ordinary skill in the art that a

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set-top box qualifies as a suitable device for performing the steps of transforming said text into speech and producing a voice output corresponding to said text.

5. In response to applicants' argument (page 7, 2<sup>nd</sup> paragraph) that Brunet does not disclose a delivery module to a messaging system capable of handling voice messages, applicant should note that Column 2 lines 31-34 is what is cited to teach this limitation and not Column 4 lines 27-32. Column 2 lines 31-34 discloses that delivery module (apparatus 20 of figure 1) adapted to delivery said output (transmits the synthesized voice signal) to a messaging system capable of handling voice messages (over a standard telephone line 30 to unit 24, which comprises a telephone microphone and telephone speaker and clearly is capable of handling voice messages).

6. In response to applicants' argument (page 8, 2<sup>nd</sup> paragraph) that the Office provided the term "message" a broader interpretation than what is reasonable in light of the specifications as mandated, applicants should note that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim limitations are read in light of the specification but are also given their broadest interpretation within reason. The interpretation given to the term "message" is well within reason and both McKissick and Brunet explicitly use the term "message" throughout their disclosure just as taught in applicants' specification.

7. In response to applicants' argument (page 8, 3<sup>rd</sup> paragraph) that Brunet is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, Brunet, like McKissick, deals with the exchange of messages between destinations through any suitable communications network including the Internet and a telephone network. Applicants should first note that a message, by definition, is information sent from a source to a receiver. Furthermore, a message is any thought or idea prepared in a form suitable for transmission by any means of communication. Outputting voice signals in the system of Brunet is a form of sending a message. When two people are talking on the phone in any form, they are sending messages back and forth to one another. Therefore, Brunet is analogous art and clearly combinable with McKissick.

8. In response to applicants' argument (page 10, 1<sup>st</sup> paragraph) that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made,

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and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. In response to applicants' argument (page 11, 3<sup>rd</sup> paragraph) that neither Brunet nor McKissick teach that the synthesized speech is to be transmitted to a voice messaging system, applicants should note that Brunet explicitly discloses that a received voice message can be directed to a voicemail and later be either viewed as a text or **read out as a voice mail** by the user (column 4, lines 11-20). In addition, **McKissick** discloses a television messaging system (figures 1A and 1B) comprising a set-top box (38 in figure 1B) capable of receiving a text message through a text entry device (34 in figure 1B) for display on television (40 in figure 1B) as well as for transmission to a target voice messaging system (**audio voice mail equipment 22 in figure 1A**) capable of receiving voice messages (paragraph 0030).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 2, 4-6, 15 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKissick et al. (EP 1458193 A2) in view of Brunet et al. (U.S. 5995590).

Considering claim 1, McKissick discloses

a set-top box in communication with the television messaging system (§ [0024] teaches a messaging system with communication path 24 and § [0025] teaches using a set top box which in figure 1A is connected to communication path 24, § [0030] teaches the television distribution facility element 16 in figure 1A also connected to communication path 24 which contains messaging equipment element 22), and adapted to deliver a message through a television coupled thereto (§ [0038] teaches a television connected to the set top box to display or deliver a message, see Figure 1A element 30);

a text receiving module executed in the set-top box (§ [0039] teaches a keyboard, figure 1B element 34, in communication with set-top box 34 for entering



messages which can be displayed on the screen so there has to be some module in the set-top box to receive the messages from the keyboard, ¶[0033] teaches a processor in the set-top box to handle television message features), and adapted to receive text from a user (¶ [0039] teaches a user can enter the messages in).

McKissick fails to disclose a text to speech module coupled to said text receiving module for transforming said text into speech, said text to speech module adapted to produce a voice output corresponding to said text; and, a voice delivery module adapted to deliver said output to a target messaging system capable of receiving voice messages.

In an analogous art, Brunet teaches a text to speech module coupled to said text receiving module for transforming said text into speech (Column 2 lines 51-58 teaches a computer being used to convert text to speech before the message is transmitted and Figure 1 teaches the text to speech module element 12 coupled to the keyboard element 14) said text to speech module adapted to produce a voice output corresponding to said text (Column 2 lines 51-58 teaches a computer being used to convert text to speech before the message is transmitted); and,

a voice delivery module adapted to deliver said output to a target messaging system capable of receiving voice messages (Figure 1 element 18 and Column 2 lines 31-34 teaches a voice delivery module, and Column 4 lines 27-32 and Figure 14 teach transmitting a voice message to a voice message receiver).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the messaging system of McKissick using the text to speech converting system of Brunet for the benefit of allowing a person who is mute to carry out a conversation with a person that is deaf.

As for claim 2, McKissick teaches a text entry device to deliver user typed text to said text receiving module (Paragraph [0039] teaches a keyboard, figure 1B element 34, in communication with set-top box 34 for entering messages which can be displayed on the screen so there has to be some module in the set-top box to receive the messages from the keyboard).

With regards to claim 4, Brunet teaches the output delivery module is adapted to transmit said output to the target voice messaging system in a speech format (Column 2 lines 31-36 teaches transmitting synthesized speech to a telephone microphone to be transmitted).

Regarding claim 5, McKissick teaches set-top box is adapted to be coupled on an IP network and deliver said output there through (Paragraph [0027] along with figure 1A teaches a set-top box in communication with the internet which is an IP network).

Considering claim 6, Brunet teaches the text to voice device wherein said target messaging system is a unified messaging system (Figure 1 and Column 2 lines 23-61 teaches a unified messaging system).

As for claim 15, McKissick teaches a text to voice messaging system operating in conjunction with a television messaging system having a television messaging system, the text messaging system comprising:

a server located remotely to a user premises (Figure 1A shows element 22 Message equipment server ¶ [0034], remote from element 26 the set top box), said server adapted to deliver messaging to a television via a downstream network (¶ [0027] teaches communication paths element 24 that messages are sent down),

a set top box coupled to said downstream network (Figure 1A element 26 is a set top box),

a text entry device in communications with said set top box (Figure 1B shows element 34 which is a wireless keyboard, Column 10 lines 45 –48), for text entry by a user (if a keyboard is used it is obvious that the user is typing in the text);

a voice delivery module adapted to deliver said output to a target messaging server adapted to receive voice messages (Paragraph 24 teaches the messages can be audio so a voice delivery module has to exist, and Figure 1A and Paragraph 34 teach an upstream network interface element which includes element 22 and server).

but fails to teach a [text to speech] module adapted to produce output representative said text in speech format.

In an analogous art Brunet teaches a [text to speech] module adapted to produce output representative said text in speech format (Column 2 lines 51-58 teaches a computer being used to convert text to speech before the message is transmitted); and, a voice delivery module adapted to deliver (Figure 1 element 18 and Column 2 lines 31-34 teaches a voice delivery module).

At the time the invention was made it would have been obvious for one skilled in the art to modify the messaging system of McKissick using the text to speech converting system of Brunet for the purpose of allowing a person who is mute to carry out a conversation with a person that is deaf.

With regards to claim 27, it is rejected for the same reasons as claim 1 and 15 above.

12. Claim 3 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKissick et al. (EP 1458193 A2) in view of Brunet et al. (U.S 5995590) and further in view of O'Neal (U.S. 6711154 B1).

Regarding claim 3, McKissick and Brunet fail to teach said output delivery module is adapted to transmit said output to the target voice messaging system in a voice data file format.

In an analogous art O'Neal teaches said output delivery module is adapted to transmit said output to the target voice messaging system in a voice data file format (Column 8 lines 44-59 teaches converting a message to Real Audio format prior to delivery).

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined systems of McKissick and Brunet with the voice data file formatted message delivery system of O'Neal for the purpose of being able to access all of his/her messages, regardless of message type, via a unified system, from either a computer or telephone (Column 3 lines 45-47, O'Neal).

13. Claims 16, 18, 19, 22, 23, 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKissick et al. (EP 1458193 A2) in view of Brunet et al. (U.S. 5995590) further in view of Ellis et al. (U.S. 6774926 B1).

Considering claim 16, McKissick teaches a messaging method (Paragraph [0019]) comprising the steps of:

outputting a message to a user using a television (Column 34 ¶ [0119] the examiner reads outputting a message as sending the message);

teaches receiving a response message from a user (¶ [0042] teaches exchanging messages with other users so one user has to be receiving a message), said response comprising text (¶ [0030] teaches messages can involve text);

delivering said output to a messaging server adapted to receive voice messages (Paragraph 24 teaches the messages can be audio so a voice delivery module has to exist, and Figure 1A and Paragraph 34 teach an upstream network interface element which includes element 22).

but fails to teach in a set-top-box transforming said text into an output in a speech format.

In an analogous art Brunet teaches transforming said text into an output in a speech format (Figure 1 element 18 and Column 2 lines 31-34 teaches a voice delivery module and Column 2 lines 51-61 teach a text to speech converter in a computer).

At the time the invention was made it would have been obvious for one skilled in the art to modify the messaging method of McKissick using the text to speech converting system of Brunet for the purpose of allowing a person who is mute to carry out a conversation with a person that is deaf.

McKissick and Brunet fail to teach a set-top box.

In an analogous art Ellis teaches a set-top box is the same as a computer (Figure 1 teaches user computer equipment element 38 and Figure 4 teaches the equipment can included a personal computer and Column 5 lines 60-67 teaches the computer can receive television programming which is what a set-top box does).

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined methods of McKissick and Brunet using the set-top box method of Ellis for the purpose of a user being able use their computer which has all the functions of a set-top box and more instead of two separate systems.

As to claim 18, McKissick teaches said set top box is coupled to a data network and wherein said step of delivering is performed via said data network (Paragraph [0024] teaches messaging being done on a data path 24 in figure 1A).

With regards to claim 19, McKissick teaches said data network is an Internet (Paragraph [0027] top of Column 8 line 2)

Regarding claim 22, it is inherent that said output comprises electrical signals representing said speech (Any type of signal representing speech or any type of information digital or analog in a wire is electric, and any type of signal traveling through the air is electromagnetic which is a type of an electric signal).

Considering claims 23 and 29, McKissick teaches a said step of delivering is performed by feeding said signals to a telephone network (Column 7 lines 11-22 teaches the use of telephone lines along data path 24).

As to claim 26, McKissick teaches a set-top box operating in conjunction with a television messaging system and adapted to deliver a message through a television coupled thereto (Figures 1A and paragraph [0024]), the set-top box comprising:

a text receiving module executed in the set-top box (Column 10 lines 42 – 45 and Column 9 lines 11-18 teach the set-top box having a processor to process the received signals from the keyboard), coupled to a keyboard for receiving text from a user ([0039] along with figure 1B teach a keyboard);

a voice delivery module adapted to deliver said output to a target messaging system capable of receiving voice messages (Paragraph 24 teaches the messages can be audio so a voice delivery module has to exist); and, an upstream network interface capable of delivering said output (Figure 1A and Paragraph 34 teach an upstream network interface element which includes element 22),

but fails to teach a text to speech module coupled to said text receiving module for transforming said text into speech, said text to speech module adapted to produce a voice output corresponding to said text.

In an analogous art Brunet teach a text to speech module coupled to said text receiving module for transforming said text into speech (Column 2 lines 51-58 teaches a computer being used to convert text to speech before the message is transmitted and Figure 1 teaches the text to speech module element 12 coupled to the keyboard element 14):



At the time the invention was made it would have been obvious for one skilled in the art to modify the messaging method of McKissick using the text to speech converting system of Brunet for the purpose of allowing a person who is mute to carry out a conversation with a person that is deaf.

McKissick and Brunet fail to teach a set-top box, and delivering said output to a messaging server adapted to receive voice messages.

In an analogous art Ellis teaches a set-top box is the same as a computer (Figure 1 teaches user computer equipment element 38 and Figure 4 teaches the equipment can included a personal computer and Column 5 lines 60-67 teaches the computer can receive television programming which is what a set-top box does).

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined methods of McKissick and Brunet using the set-top box method of Ellis for the purpose of a user being able use their computer which has all the functions of a set-top box and more instead of two separate systems.

14. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over McKissick et al. (EP 1458193 A2) in view of Brunet et al. (U.S. 5995590) further in view of Ellis et al. (U.S. 6774926 B1) further in view of O'Neal (U.S. 6711154 B1).

With regards to claim 21, McKissick, Brunet, and Ellis fail to teach said output is in the form of a file containing data representing said speech.

In an analogous art O'Neal teaches said said output is in the form of a file containing data representing said speech (Column 8 lines 44-59 teaches converting a message to Real Audio format prior to delivery).

A the time the invention was made it would have been obvious for one skilled in the art to modify the combined methods of McKissick, Brunet, and Ellis with the voice data file formatted message delivery system of O'Neal for the purpose of being able to access all of his/her messages, regardless of message type, via a unified system, from either a computer or telephone (Column 3 lines 45-47, O'Neal).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harun M. Yimam whose telephone number is 571-272-7260. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HMY



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